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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/737,330

12/17/2003

Michael Anthony Zerillo

7560

7590

12/21/2005

MICHAEL A. ZERILLO  
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EXAMINER

HAWK, NOAH CHANDLER

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/737,330

Applicant(s)

ZERILLO, MICHAEL ANTHONY

Examiner

Noah C. Hawk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. The submission, however, is not fully responsive to the prior Office action because although the applicant has entered an amended set of claims, the applicant has failed to include remarks addressing all of the rejections made in the Final Office Action dated 10/18/05. However, since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant's submission filed on 11/3/05 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, the applicant recites that "the motor

comprises a brake means” on page 2, line 14 and further recites “the motor brake” on page 2, line 21, page 3, lines 11 and 17, and page 4, lines 6 and 12. In claim 2, the applicant recites that “the motor comprises a brake means” on page 5, line 17 and further recites “the motor brake” on page 5, line 24 and page 6, lines 5, 10, 19 and 24. In claim 3, the applicant recites that “the motor comprises a brake means” on page 8, line 1 and further recites “the motor brake” on page 8, lines 8, 20 and 25 and on page 9, lines 3 and 8. Because the applicant did not include any recitation in the original or amended claims or disclosure in the original specification or the drawings, the “motor brake” element is considered new matter and any limitations drawn to this element will not be given any patentable weight.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In Claim 1, the phrase beginning “the patio umbrellas comprise a mast...” on page 1, line 20 and ending with the phrase “...to lower to a closed position” on page 2, line 6, renders the claim indefinite. The instant claim recites a “retrofit motor and control kit” but includes language reciting an umbrella onto which the kit may be installed. It is unclear whether the applicant intends to claim the “retrofit motor and control kit” alone or the combination of the “retrofit motor and

control kit” and associated umbrella. For the purposes of this examination, the Office interprets claim 1 to be directed only to the “retrofit motor and control kit”. Any language regarding the umbrella will not be considered.

b. In Claim 2, the phrase beginning “the patio umbrellas comprise a mast...” on page 4, line 19 and ending with the phrase “...to lower to a closed position” on page 5, line 8, renders the claim indefinite. The instant claim recites a “retrofit motor and control kit” but includes language reciting an umbrella onto which the kit may be installed. It is unclear whether the applicant intends to claim the “retrofit motor and control kit” alone or the combination of the “retrofit motor and control kit” and associated umbrella. For the purposes of this examination, the Office interprets claim 2 to be directed only to the “retrofit motor and control kit”. Any language regarding the umbrella will not be considered.

c. In Claim 3, the phrase beginning “the patio umbrellas comprise a mast...” on page 6, line 31 and ending with the phrase “...the reel brake that present the yoke from moving” on page 7, line 23, renders the claim indefinite. The instant claim recites a “retrofit motor and control kit” but includes language reciting an umbrella onto which the kit may be installed. It is unclear whether the applicant intends to claim the “retrofit motor and control kit” alone or the combination of the “retrofit motor and control kit” and associated umbrella. For the purposes of this examination, the Office interprets claim 3 to be directed only to the “retrofit motor and control kit”. Any language regarding the umbrella will not be considered.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

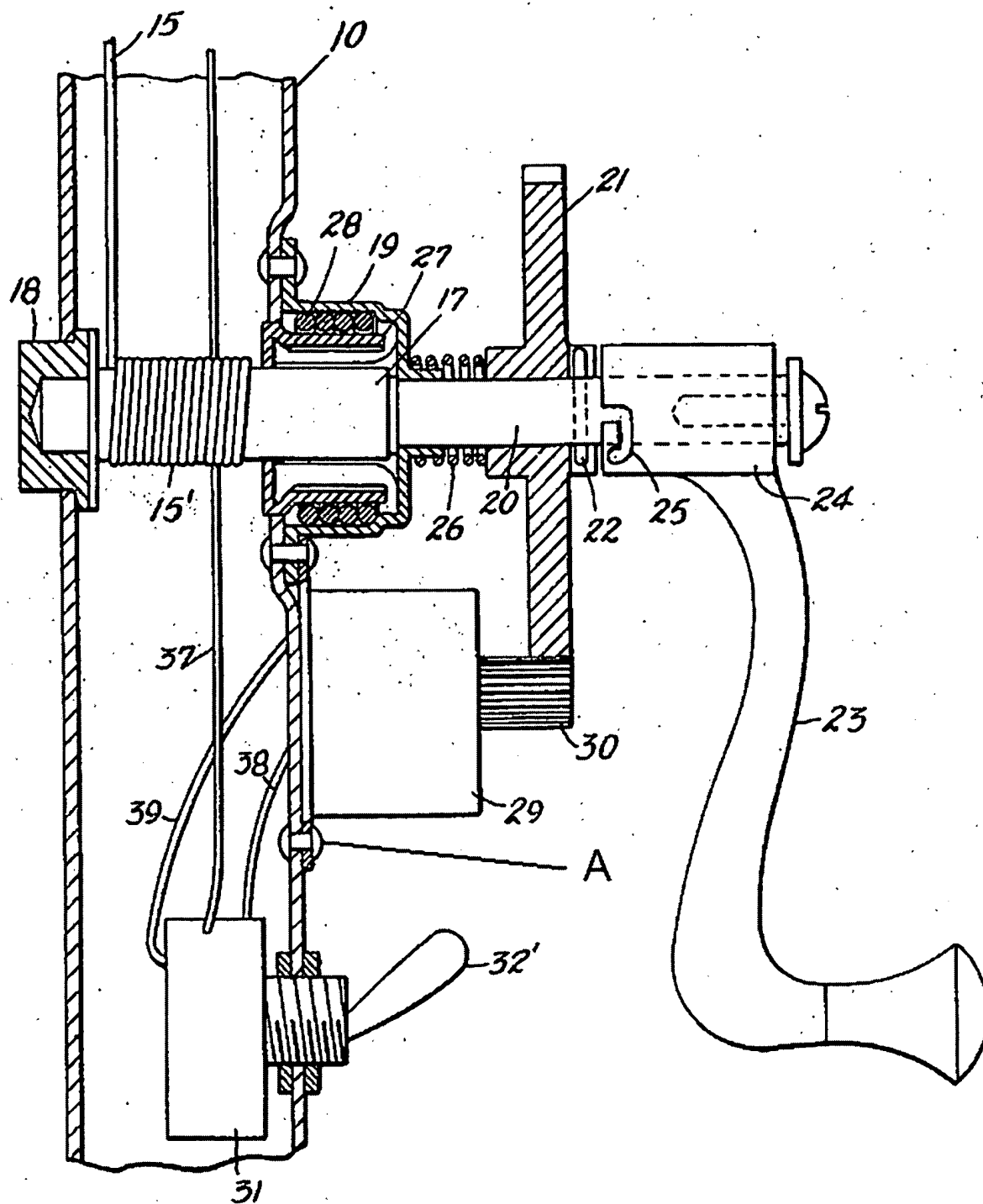
7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in US Patent 6182917 in view of Small in US Patent 2960094. Lai discloses a “retrofit” motor and control kit for umbrellas capable of providing a substitute means to open and close a patio umbrella, the device comprising a housing means (12), a reversible electric motor (21), a means to provide electricity (see Lai, Column 4, lines 14-15), a reel drivingly engaged with the motor (24) and when the electricity is applied to the motor, the motor rotates the reel and the when the electricity is disconnected the motor and reel stop rotating (see Lai, Column 2, lines 38-40), and a length of cable (33) affixable at one end to the reel. Lai further discloses a switch control (10) having two means (see Lai, Column 4, lines 12-15) to connect and disconnect the electricity to the motor and a remote control receiver switch (11) having two means (See Lai, Column 4, lines 12-15) to connect and disconnect the electricity to the motor and a remote control transmitter (See Lai, Column 1, lines 26-28) having means to control the remote control receiver switch. Lai is silent on which direction the motor turns as it relates to the controlling element of the switch control or the remote control receiver switch. However, it would be obvious for the engagement of a first switch means or first receiver switch means in a controlling element such as a switch control or remote control receiver switch to connect electricity to the motor and cause the motor to operate in a first direction of rotation

thereby causing the umbrella to open and for disengagement of a first switch means or first receiver switch means in a switch control or remote control receiver switch to disconnect electricity from the motor to thereby cause it to stop operating and cause the umbrella to stop opening. Further, it would be obvious for the engagement of a second switch means or second receiver switch means in a controlling element such as a switch control or remote control receiver switch to connect electricity to the motor and cause the motor to operate in a second direction of rotation thereby causing the umbrella to close and for disengagement of the second switch means or second receiver switch means in a controlling element such as a switch control or remote control receiver switch to disconnect the electricity from the motor to thereby cause the motor to stop operating and cause the umbrella to stop closing. Additionally, it would be obvious that the weight of an umbrella canopy and gravity would cause the umbrella to close if not supported by an uplifting force. Lai does not disclose that the opposite end of the cable is affixable at the opposite end to the yoke of an umbrella, nor does he disclose a means to affix the housing to the mast at a location to thereby establish control of the yoke of the patio umbrella or that the motor is affixed to the housing. Small discloses a motor device for an umbrella, the device having a cable (15) affixed at one end to a reel (17), the opposite end of the cable being affixable (see Small, Column 1, lines 50-54) to the yoke (13) of a patio umbrella. Small also discloses a means (A) to affix the housing to the patio umbrella at a location to thereby establish control of the yoke of the patio umbrella and that the motor (29) is affixed to the housing (best seen in Small, Figure 2). It would have been obvious to one of ordinary skill in the art at the time

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of invention to modify the device of Lai by using a cable attached at an opposite end to the yoke of the patio umbrella, to use means to attach the housing at a location to thereby establish control of the yoke of the patio umbrella and to affix the motor to the housing in order to ensure that the motor is in control of the operation of the umbrella and that it is firmly attached at a convenient position to the umbrella. Please note that the limitations "thereby the motor and control kit substitutes for the function of manually hand lifting and lowering the yoke and controls the canopy opening means and the canopy closing means of patio umbrellas" on page 3, lines 18-20 and page 4, lines 12-14 constitute functional language and have been given no patentable weight.





**Small, Figure 2**

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in US Patent 6182917 in view of Small in US Patent 2960094. Lai discloses a "retrofit" motor and control kit for umbrellas capable of providing a substitute means to open and close a patio umbrella, the device comprising a housing means (12), a reversible electric motor (21), a means to provide electricity (see Lai, Column 4, lines 14-15), a reel drivingly engaged with the motor (24) and when the electricity is applied to the motor, the motor rotates the reel and the when the electricity is disconnected the motor and reel stop rotating (see Lai, Column 2, lines 38-40), and a length of cable (33) affixable at one end to the reel. Lai further discloses a switch control (10) having two means (see Lai, Column 4, lines 12-15) to connect and disconnect the electricity to the motor and a remote control receiver switch (11) having two means (See Lai, Column 4, lines 12-15) to connect and disconnect the electricity to the motor and a remote control transmitter (See Lai, Column 1, lines 26-28) having means to control the remote control receiver switch. Lai is silent on which direction the motor turns as it relates to the controlling element of the switch control or the remote control receiver switch. However, it would be obvious for the engagement of a first switch means or first receiver switch means in a controlling element such as a switch control or remote control receiver switch to connect electricity to the motor and cause the motor to operate in a first direction of rotation thereby causing the umbrella to open and for disengagement of a first switch means or first receiver switch means in a switch control or remote control receiver switch to disconnect electricity from the motor to thereby cause it to stop operating and cause the umbrella to stop opening. Further, it would be obvious for the engagement of a second

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switch means or second receiver switch means in a controlling element such as a switch control or remote control receiver switch to connect electricity to the motor and cause the motor to operate in a second direction of rotation thereby causing the umbrella to close and for disengagement of the second switch means or second receiver switch means in a controlling element such as a switch control or remote control receiver switch to disconnect the electricity from the motor to thereby cause the motor to stop operating and cause the umbrella to stop closing. Additionally, it would be obvious that the weight of an umbrella canopy and gravity would cause the umbrella to close if not supported by an uplifting force. Lai does not disclose that the opposite end of the cable is affixable at the opposite end to the yoke of an umbrella, nor does he disclose a means to affix the housing to the mast at a location to thereby establish control of the yoke of the patio umbrella or that the motor is affixed to the housing. Small discloses a motor device for an umbrella, the device having a cable (15) affixed at one end to a reel (17), the opposite end of the cable being affixable (see Small, Column 1, lines 50-54) to the yoke (13) of a patio umbrella. Small also discloses a means (A) to affix the housing to the patio umbrella at a location to thereby establish control of the yoke of the patio umbrella and that the motor (29) is affixed to the housing (best seen in Small, Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Lai by using a cable attached at an opposite end to the yoke of the patio umbrella, to use means to attach the housing at a location to thereby establish control of the yoke of the patio umbrella and to affix the motor to the housing in order to ensure that the motor is in control of the operation of the umbrella

and that it is firmly attached at a convenient position to the umbrella. Please note that the limitations "thereby the motor and control kit substitutes for the function of manually hand pulling and raising the ropes that operate the canopy opening means and the canopy closing means of patio umbrellas" on page 6, lines 10-12 and page 6, lines 24-26 constitute functional language and have been given no patentable weight.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in US Patent 6182917 in view of Small in US Patent 2960094. Lai discloses a "retrofit" motor and control kit for umbrellas capable of providing a substitute means to open and close a patio umbrella, the device comprising a housing means (12), a reversible electric motor (21), a means to provide electricity (see Lai, Column 4, lines 14-15), a reel drivingly engaged with the motor (24) and when the electricity is applied to the motor, the motor rotates the reel and the when the electricity is disconnected the motor and reel stop rotating (see Lai, Column 2, lines 38-40), and a length of cable (33) affixable at one end to the reel. Lai further discloses a switch control (10) having two means (see Lai, Column 4, lines 12-15) to connect and disconnect the electricity to the motor and a remote control receiver switch (11) having two means (See Lai, Column 4, lines 12-15) to connect and disconnect the electricity to the motor and a remote control transmitter (See Lai, Column 1, lines 26-28) having means to control the remote control receiver switch. Lai is silent on which direction the motor turns as it relates to the controlling element of the switch control or the remote control receiver switch. However, it would be obvious for the engagement of a first switch means or first receiver switch means in a controlling element such as a switch control or remote control receiver switch to connect

electricity to the motor and cause the motor to operate in a first direction of rotation thereby causing the umbrella to open and for disengagement of a first switch means or first receiver switch means in a switch control or remote control receiver switch to disconnect electricity from the motor to thereby cause it to stop operating and cause the umbrella to stop opening. Further, it would be obvious for the engagement of a second switch means or second receiver switch means in a controlling element such as a switch control or remote control receiver switch to connect electricity to the motor and cause the motor to operate in a second direction of rotation thereby causing the umbrella to close and for disengagement of the second switch means or second receiver switch means in a controlling element such as a switch control or remote control receiver switch to disconnect the electricity from the motor to thereby cause the motor to stop operating and cause the umbrella to stop closing. Additionally, it would be obvious that the weight of an umbrella canopy and gravity would cause the umbrella to close if not supported by an uplifting force. Lai does not disclose that the opposite end of the cable is affixable at the opposite end to the yoke of an umbrella, nor does he disclose a means to affix the housing to the mast at a location to thereby establish control of the yoke of the patio umbrella or that the motor is affixed to the housing. Small discloses a motor device for an umbrella, the device having a cable (15) affixed at one end to a reel (17), the opposite end of the cable being affixable (see Small, Column 1, lines 50-54) to the yoke (13) of a patio umbrella. Small also discloses a means (A) to affix the housing to the patio umbrella at a location to thereby establish control of the yoke of the patio umbrella and that the motor (29) is affixed to the housing (best seen in

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Small, Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Lai by using a cable attached at an opposite end to the yoke of the patio umbrella, to use means to attach the housing at a location to thereby establish control of the yoke of the patio umbrella and to affix the motor to the housing in order to ensure that the motor is in control of the operation of the umbrella and that it is firmly attached at a convenient position to the umbrella. Please note that the limitations "thereby the motor and control kit substitutes for the function of manually hand cranking a mechanism to operate the canopy opening means and the canopy closing means of patio umbrellas" on page 8, lines 25-27 and page 9, lines 8-10 constitute functional language and have been given no patentable weight.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hung in US Publication 2005/0247332 discloses a motor-driven umbrella.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah C. Hawk whose telephone number is 571-272-1480. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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12/13/05

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